

REMARKS

A revised Figure 8 is submitted herewith for the Examiner's approval. The linking between Figures 7 and 8 has been removed, and continuation indicators added to Figure 8. No new matter is added.

Claim 17 is amended herein to explicitly recite that the ribs are nonintersecting. Support for this amendment is found at least in Figures 1, 2, 3, 4 and 5. Claim 22 is amended herein to correct typographical errors as noted by the Examiner, without altering the scope thereof. No new matter is added.

35 U.S.C. § 102 Rejection of claims 10 and 22

The Examiner rejected claims 10 and 22 under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,368,245 to Fore ("Fore"). Claims 10 and 22 are directed to a cable pay-out tube with a retaining clip. Claim 22, for example, recites a "cable retainer including a surface having at least one slit formed therein that defines two sections, at least one section being deflectable and which opens in response to the cable being inserted between the two sections permitting the cable to be moved between the two sections and be held by the two sections." By the plain language of claim 22, the cable retainer comprises at least two sections, one of which is deflectable. Claim 22 clearly recites that the sections that comprise the cable retainer are sections of a surface – a surface that has been divided into those sections by at least one slit formed therein.

Fore discloses a pay-out tube having a clip attached to an exterior surface thereof for retaining the cable end. See Figure 1.

To retain and hold the remote end of the cable extending from the container and the pay-out tube 10, there is provided a cable clip 36 formed on the outer face of the outer flange 32. . . . [T]he clip 36 can be pulled open and a cable can be slipped thereunder in such a fashion that the cable clip 36 will retain the terminal end of the cable against the outer face of the outer flange 32.

col. 3, line 64 – col. 4, line 6. The Examiner stated, “The cable retainer includes a surface divided by a slot (between 32 and 36) that forms two sections 32, 36, one of which is deflectable relative to the other...” First, neither claim 10 nor 22 recites a slot – the claims recite a slit. A slit is narrower than a slot. More importantly, the clip 36 is not a section of a surface defined by the outer face of the outer flange 32, the section formed by a slit in the surface. Rather, the clip 36 is an element distinct from the surface 32, having a unique three-dimensional shape and distinct properties, e.g., its resilience and deformability independent of the surface 32. The clip 36 does not reside in the same plane as the surface 32, and is not defined from the surface 32 solely by a slit. As Fore fails to disclose each and every claimed element – in particular, a cable retainer comprising a deflectable section of a surface formed in said surface by at least one slit – claims 10 and 22 are patentably novel over Fore.

35 U.S.C. § 103 Rejection of claims 10-16 and 22-24

The Examiner rejected claims 10-16 and 22-24 under 35 U.S.C. § 103(a) as being unpatentable over Fore in combination with U.S. Patent No. 3,516,111 to Heyman (“Heyman”). To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference or to combine reference teachings. The teaching or suggestion to make the claimed combination must be found in the prior art, not in applicant's disclosure. MPEP § 2143. The Examiner stated,

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the container of Fore in association with a bushing through which cable is passed as taught by Heyman to retain and protect cable removed from the container of Fore and passed through a wall or panel during installation of the cable.

This proffered motivation is completely inapposite to Applicant's invention. Cable removed from a cable container through Applicant's inventive pay-out tube may or may not be subsequently passed through a wall or panel. If it is passed through a wall or panel during installation, it may or may not benefit from the bushing of Heyman being placed in that wall or panel. Any disposition of cable removed from the container, or its use during installation, is

irrelevant to the present invention, the purpose of which is to facilitate such removal prior to (or at least as the necessarily first step of) installing the cable.

Rather, the purpose of the cable retainer of Applicant's pay-out tube, as clearly defined in the Specification, is to retain the end of the cable following installation, or between installation jobs, *i.e.*, when cable is not being extracted from the container:

To retain cable end when not dispensing, . . . the cable end is introduced into retainer 60 causing opening of one or more slits 62a and 62b due to deflection of one or more segments 63a, 63b, 63c, or 63d and allowing cable end to pass through slits 62a and 62b. The cable is held in place by the binding action of one or more segments 63a, 63b, 63c, and 63d against cable 52.

Specification, p. 7, line 19 – p. 8, line 2. Note that it is only the cable end that is held in place by the retainer, that is, the end of the cable remaining in the container – not the cable removed from the container as the Examiner suggests – that is secured by the retainer.

In fact, the Examiner's proffered motivation is not logical. The retainer formed by one or more slits in the surface of Applicant's pay-out tube holds the cable end when the cable end is inserted through the slit(s) in a direction leading back into the cable container. The retainer could not possibly "retain and protect cable . . . passed through a wall or panel during installation of the cable" as the Examiner suggests, when the cable is being fed back into the cable container through the inventive cable retainer.

Furthermore, even truncating the Examiner's proffered motivation after "to retain and protect cable" – a purely *arguendo* argument on Applicant's part – the motivation still fails to support a *prima facie* case of obviousness. Such a motivation flows solely and directly from Applicant's Specification (p. 2, lines 11-15):

[M]any conventional pay-out tubes provide no means of retaining and holding the terminal end of the cable once pulled from the winding, and they thus allow the terminal end of the cable to hang free and uncontrolled such that often the terminal end of the cable inadvertently retracts within the winding in the container requiring a difficult procedure to extract it.

The motivation to combine references cannot come from the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner has cited to no deficiency in the retaining clip of Fore that would lead one of ordinary skill in the art to modify the teachings of that reference in the manner suggested. Nor has the Examiner cited to any knowledge or experience in the art generally that would suggest such motivation. Assuming *arguendo* that such motivation existed, the Examiner has not articulated anything that would lead one of skill in the art to the teachings of Hayman. In short, the Examiner has completely failed to establish a *prima facie* case of obviousness with respect to claims 10 or 22. Accordingly, both claims, and all claims depending from them, exhibit patentable nonobviousness over the cited reference.

The Examiner cursorily rejected claims 14-16 under the same combination. As discussed above, this combination is improper, and fails to establish a *prima facie* case of obviousness. Additionally, the Examiner stated, "Note than an end portion of cable could be retained by the retainer taught by Heyman during the cable installation process." This is incorrect; the retainer only retains the end of the cable remaining within the cable container, following a given cable installation operation (during which cable was extracted from the container through the pay-out tube). For the same reasons discussed above, claims 14-16 are patentably nonobvious over the cited art.

35 U.S.C. § 103 Rejection of claims 17-19 and 21

The Examiner rejected claims 17-19 and 21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,520,347 to Bass *et al.* ("Bass") in combination with U.S. Patent No. 4,057,203 to Newman *et al.* ("Newman"). Bass discloses a pay-out tube wherein "A plurality of strengthening ribs are located on the underside of the flange and extend along the outer wall of the tube, with certain ones of the ribs intersecting other ribs at right angles thereto." Abstract. See also, Figures 3, 5, and 6. Claim 17 is amended herein to recite, "the tube portion including a surrounding wall having a thickness and a series of spaced-apart, nonintersecting ribs integrally molded into the wall." Bass does not disclose a pay-out tube with nonintersecting ribs. The combination with Newman does not cure this deficiency. Hence, the combination of

Bass and Newman does not disclose each and every feature recited in claim 17. Accordingly, claims 17-21 are patentably nonobvious over the cited art.

Respectfully submitted,

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